

REMARKS

Responsive to the Office Action mailed June 2, 2003, reconsideration of the present application is respectfully requested. Claims 1-6, 8-13, and 18-45 were rejected. Claims 7 and 14-17 have been allowed. Claims 11-13 have been cancelled without prejudice or disclaimer. Claims 1-6, 8-10, and 18-45 are pending.

Claims 1-4 were rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 5,447,564 to Xie et al. ("Xie"). Claim 1 has been amended to include the limitation of "a plurality of concrete slabs in spaced relation." Xie does not disclose "a plurality of concrete slabs" for use in a bridge deck application. Thus, claim 1 is believed to be in condition for allowance and such favorable action is respectfully requested. Because claims 2-4 depend from claim 1, claims 2-4 are believed to be in condition for allowance for at least the above cited reasons. As such, Applicants respectfully request withdrawal of the § 102(a) rejection of claims 2-4. Thus claims 2-4 are believed to be in condition for allowance and such favorable action is respectfully requested.

Claim 5 was rejected under 35 U.S.C. 103(a) as being unpatentable over Xie in view of CA836117. Because claim 5 depends from claim 1, claim 5 is believed to be in condition for allowance for at least the above cited reasons. As such, Applicants respectfully request withdrawal of the § 103(a) rejection of claim 5. Thus claim 5 is believed to be in condition for allowance and such favorable action is respectfully requested.

Claim 6 was rejected under 35 U.S.C. 103(a) as being unpatentable over Xie in view of CA836117 and further in view of U.S. Patent No. 3,573,427 to Minsk ("Minsk"). Because claim 6 depends from claim 1, claim 6 is believed to be in condition for allowance for at least the above cited reasons. As such, Applicants respectfully request withdrawal of the §

103(a) rejection of claim 6. Thus claim 6 is believed to be in condition for allowance and such favorable action is respectfully requested.

Claim 7 has been allowed.

Claims 8, 9, and 27-44 were rejected under 35 U.S.C. §102(a) as being anticipated by the article by Sherif Yehia and Christopher Y. Tuan, (hereinafter “Yehia & Tuan”). The inventors on the application were Christopher Y. Tuan, Sherif Yehia, Bing Chen, and Lim Nguyen. The article from Crossroads 2000 (Iowa State Univ.) entitled “Bridge Deck Deicing” to Yehia and Tuan was presented at a conference and was used to reject claims 8, 9, and 27-44. Conferences are generally specific to a theme, or to a particular subject matter (i.e. road construction techniques for civil engineers, etc...) and generally speaking ONLY people in that scientific community participate in the conference. In this case the conference was a civil engineering conference, so only Chris Tuan and Sherif Yehia attended, and they were the only ones who presented the paper. As the only two presenters, they were the only two authors listed when the conference paper was published in the proceedings of the conference. Lim Nguyen and Bing Chen are electrical engineers and did not attend the conference. However, they are cited in the acknowledgement section of the conference paper, which does recognize their participation and contribution to the research for the article. Lim Nguyen and Bing Chen did participate in the research for and preparation of the article and subsequently the patent application.

A 37 C.F.R. § 1.132 affidavit has been submitted attesting to the above statements with a unequivocal statement from each applicant regarding the subject matter of the article and stating that Yehia & Tuan, as well as, Bing Chen and Lim Nguyen all participated in the preparation of the materials for the article and then, subsequently the patent application. An event stemming from the inventor’s own activity cannot constitute a §102(a) event, because it

could not have occurred before the inventor's invention. *In re Katz*, 687 F. 2d 450, 215 USPQ 14 (CCPA 1982). Thus, Applicant respectfully requests withdrawal of the 102 (a) reference and the rejections for claims 8, 9, and 27-44. Claims 8, 9, and 27-44 are now in condition for allowance.

Claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Yehia & Tuan. As stated above, this reference is not a proper prior art reference so it may not be used as a reference under 103(a). Further, because claim 10 depends directly from claim 9, claim 10 is believed to be in condition for allowance for at least the above cited reasons. As such, Applicants respectfully request withdrawal of the § 103(a) rejection of claim 10. Thus claim 10 is believed to be in condition for allowance and such favorable action is respectfully requested.

Claims 11-13 have been cancelled without prejudice or disclaimer.

Claims 14-17 have been allowed.

Claim 18 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Xie in view of CA836117. Claim 18 has been amended to include "a plurality of concrete slabs in spaced relation." Neither the Xie nor the CA836117 reference either singularly or in combination disclose a plurality of concrete slabs in spaced relation for use in a bridge deck. As such, Applicants respectfully request withdrawal of the § 103(a) rejection of claim 18. Thus claim 18 is believed to be in condition for allowance and such favorable action is respectfully requested.

Claims 19 and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Xie in view of CA836117 and further in view of U.S. Patent No. 3,573,427 to Minsk ("Minsk"). However, because claims 19 and 20 depend directly from claim 18, claims 19 and 20 are believed to be in condition for allowance for at least the above cited reasons. As such,

Applicants respectfully request withdrawal of the § 103(a) rejection of claims 19 and 20. Thus claims 19 and 20 are believed to be in condition for allowance and such favorable action is respectfully requested.

Claims 21, 23, 24, and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Xie in view of CA836117, Minsk, and further in view of the Yehia and Tuan article. As stated above, the Yehia and Tuan article is not a proper prior art reference so it may not be used as a reference under 103(a). As such, Applicants respectfully request withdrawal of the § 103(a) rejection of claims 21, 23, 24, and 26. Further, claims 21, 23, 24, and 26 depend directly from claim 18. Thus, claims 21, 23, 24, and 26 are believed to be in condition for allowance for at least the above cited reasons and such favorable action is respectfully requested.

Claims 22 and 25 were rejected under 35 U.S.C. 103(a) as being unpatentable over Xie in view of CA836117, and further in view of U.S. Patent No. 3,573,427 to Minsk ("Minsk"). However, because claims 22 and 25 depend directly from claim 18, claims 22 and 25 are believed to be in condition for allowance for at least the above cited reasons. As such, Applicants respectfully request withdrawal of the § 103(a) rejection of claims 22 and 25. Thus claims 22 and 25 are believed to be in condition for allowance and such favorable action is respectfully requested.

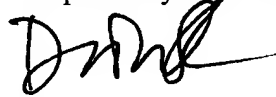
Claim 45 was rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 1,473,047 to Rau ("Rau") and in the alternative, under 35 U.S.C. § 103(a) as being obvious over Rau. Applicant claims a mixture that is composed of mortar and sawdust while Rau disclosed a mixture of plaster of Paris, slacked lime, sawdust, and corn stalks. Not only do the two differ in ingredients, each also has different purposes and physical characteristic requirements. Applicant's mixture is for use as a thermal insulating layer on a concrete bridge

deck; Rau's mixture is to be used in building tiles. Applicant's mixture is not required to be strong and impervious to dampness as Rau's is. These substantive differences in composition and uses are not obvious to one skilled in the art. For at least these reasons, claim 45 should be allowed.

CONCLUSION

The claims now pending in the application, namely claims 1-10 and 14-45 are in condition for allowance and such allowance is respectfully requested. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned by telephone prior to issuing a subsequent action. The Commissioner is hereby authorized to charge any additional amount required, or credit any overpayment, to Deposit Account No. 19-2112.

Respectfully submitted,



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